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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,009	01/14/2004	James R. Matera JR.	1021-3 CON	3306

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EXAMINER

EREZO, DARWIN P

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,009

Applicant(s)

MATERA, JAMES R.

Examiner

Darwin P. Erez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 11-16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,719,825 to LaHaye et al.

(claim 11) LaHaye teaches a surgical procedure comprising the steps of positioning an ink dispensing instrument **10** having sterilized tattoo ink therein adjacent a patient (col. 3, lines 1-6); releasing the tattoo ink through a port (hole within needle **12**) of the ink dispensing instrument and onto body tissue of a patient to selectively mark the body tissue to generally correspond to a target location for radiation therapy (col. 3, line 60); and dispensing the ink dispensing instrument after use on the patient (it is inherent in the surgical art to dispose surgical needles after use for safety reasons).

(claims 12 and 20) LaHaye teaches a surgical dispensing instrument comprising an ink cartridge **10** defining an enclosed internal chamber; and a sterile tattoo ink

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disposed within the enclosed internal chamber of the ink cartridge (col. 3, lines 1-6), wherein the device is disposable.

(claim 13) LaHaye teaches the ink cartridge defining a port in communication with the internal chamber (inherent since ink flows from the internal chamber to the needle **12**).

(claim 14) LaHaye teaches an enclosure **40** covering ink cartridge **10** which would also cover the port of said cartridge.

(claim 15) LaHaye teaches a releasably mounted ink cartridge (col. 3, lines 10-13).

(claim 16) LaHaye teaches enclosure **40** as an end cap.

(claims 18 and 19) LaHaye teaches a needle **12** in communication with the port of the cartridge).

3. Claims 11-17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,056,737 to Rosen.

(claim 11) Rosen teaches a surgical procedure comprising the steps of positioning an ink dispensing instrument **10** having sterilized tattoo ink therein adjacent a patient (col. 5, lines 42-43); releasing the tattoo ink through a port **44** of the ink dispensing instrument and onto body tissue of a patient to selectively mark the body tissue to generally correspond to a target location for radiation therapy; and dispensing the ink dispensing instrument after use on the patient (the device is disposable).

(claims 12 and 20) Rosen teaches a surgical dispensing instrument comprising an ink cartridge **10** defining an enclosed internal chamber; and a sterile tattoo ink **33**

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disposed within the enclosed internal chamber of the ink cartridge; wherein the device is disposable.

(claim 13) Rosen teaches the ink cartridge defining a port **44** in communication with the internal chamber.

(claim 14) Rosen teaches an enclosure **40** covering the port.

(claim 15) Rosen teaches a releasably mounted ink cartridge.

(claim 16) Rosen teaches enclosure **40** as an end cap.

(claim 17) Rosen teaches a flexible ink cartridge (col. 2, lines 65-67).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who whose telephone number is (571) 272-4695. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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[Signature]
GARY L. JOHNSON
PROPERTY EXAMINER